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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/731,332	12/08/2003	John W. Rohrer		5081

7590

04/26/2005

John W. Rohrer  
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5 Long Cove Rd.  
York, ME 03909

EXAMINER

BLAU, STEPHEN LUTHER

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 04/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/731,332	ROHRER, JOHN W.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Stephen L. Blau	3711	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 March 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 4-19 is/are pending in the application.
- 4a) Of the above claim(s) 4,7,8,11 and 14-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,5,6,9,10,12,13 and 19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. The supplemental amendment dated 23 March 2005 has been reevaluated and it has been determined that it is proper in that all the omissions and corrections stated on the non-responsive action dated 2 March 2005 have been submitted in it. The signature was presented in the response dated 17 December 2004 and was not required in the amendment dated 23 March 2005.

### ***Specification***

2. The substitute specification and abstract has been approved.

### ***Claim Rejections - 35 USC § 112***

3. The changes to claim 1 are agreed with and the rejections under 35 U.S.C. 112, second paragraph, are removed.

### ***Claim Rejections - 35 USC § 102***

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4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 5-6, 9-10 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Downey.

Downey discloses a golf club grip (Title) including two or more hard or rigid vibration transmitting elements in the form of two protrusions (Ref. No. 20, Figs. 6-7, Col. 3, Lns. 57-60) in intimate contact with a shaft and a golfer's hand or hands (Fig. 6), elements being positioned with a grip at locations where transmission are found in the form of there will always be vibrations on a handle when a club hits a ball hard enough, elements omitted at locations where undesirable impact vibrations are found in the form of where Downey chose to not place the elements and place softer material (Ref. Nos. 14, 18, Figs. 6-7), a grip area around elements having a layer of softer material which at least partially insulate or absorb the undesirable impact vibrations (Ref. Nos. 14, 18, Figs. 6-7, Col. 9, Lns. 55-60), elements being metal (Col. 4, Lns. 11-13), an element being an other symmetrical shape in the form of a triangle (Fig. 5), an element being embedded through a softer rubber (Fig. 6, Col. 4, Lns. 3-12), a slip-on type grip (Fig. 5), and an element is flush with a surface of a softer grip material (Fig. 6).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Downey in view of Kobayashi.

Downey lacks an element being attached to a shaft prior to placing a softer grip material around an element. Kobayashi discloses attaching an inner jacket prior to placing a softer elastomer material around the inner jacket (Col. 3, Lns. 42-49). In view of the patent of Kobayashi it would have been obvious to modify the grip of Downey to have an element being attached to a shaft prior to placing a softer grip material around an element in order to simplify the assembly process by not having to use a mandrel and then take the grip off a mandrel and then place it on a shaft.

8. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Downey in view of Bloom.

Downey lacks a shaft back weighted within four inches of the top with lead or tungsten in such a manner to relocate vibration to elements on a grip. Bloom discloses a shaft back weighted within four inches of the top (Figs. 2, 4) with lead or tungsten (Col. 4, Lns. 51-53) in such a manner which would relocate vibration on a grip in the

form that this device will change the vibration profile felt along a grip and lessen it near the end (Col. 5, Lns. 6-13) in order to have frictionally dissipative vibration damping counterweights (Title). In view of the patent of Bloom it would have been obvious to modify the grip of Downey to be part of a club with a shaft back weighted within four inches of the top with lead or tungsten in such a manner to relocate vibration to elements on a grip in order to both adjust the swing weight of a club while also reducing vibrations for a golfer who needs both.

### ***Response to Arguments***

9. This action is not made final due to the first time claim 19 is being rejected. The arguments that Downey is improper due to Downey never describing or claiming enhanced vibration transmission and Downey's projecting protrusions are not rigid vibration transmitting elements are disagreed with. Downey does not have to state or claim a condition to be true. Clearly Downey does disclose stiff material which will transmit vibrations and which are able to be used by a golfer to feel an impact. The argument that it is improper to use the reference of Downey since Downey discloses protrusions being rubber or other soft elastomer is disagreed with. Downey also discloses plastics and metal (Col. 4, Lns. 3-18). Clearly Downey is attempting to use both rigid and softer materials to overcome the disadvantages of having only a rigid grip or having a soft grip (Col. 1, Lns. 55-62). The argument that the reference of Downey is improper due to not selectively positioning to only transmit desirable initial impact

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vibrations to a golfer's hands is disagreed with. One of the main purposes of a grip is to bring comfort to a player and minimize damage to a player's body due to vibrations when impacting a ball. Clearly the design of Downey and the placement of the protrusions (elements), the structure between the protrusions, the jacket material and the socket material all are taken into account to produce the desired vibration profile felt by a player at impact as well as the torsional performance. The argument that Downey is improper due to Downey having the socket and jacket both molded and fully bonded or "cross linked" to each other is disagreed with. Nothing in the claims prevents these materials from being fully bonded together. The argument that the reference of Downey is improper due to the jacket having little or no contact with the shaft is disagreed with. Nothing in the claims requires the softer material to be in contact with the shaft. The argument that the reference of Downey is improper due to the situation of if the socket were metal or other rigid material there would not be selective placement of individual elements is disagreed with. The fact that the socket in the hand side of the grip is designed into a plurality of protrusions the grip is selecting where on the outside of the grip the rigid material is which will the most vibrations. The argument that the reference of Kobayashi is improper since Kobayashi discloses an unitary inner layer and would not be able to selectively transmit desired vibrations while insulating undesirable vibrations is disagreed with. Kobayashi was not used for this but to show that it is known to assemble different parts of a grip right onto a shaft. Downey was used to show the selective transmission of vibrations using rigid protrusions.

***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Blau whose telephone number is (571) 272-4406. The examiner is available Monday through Friday from 8 a.m. to 4:30 p.m.. If the examiner is unavailable you can contact his supervisor Greg Vidovich whose telephone number is (571) 272-4415. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0858. (TC 3700 Official Fax 703-872-9306)

slb/ 22 April 2005

  
**STEPHEN BLAU**  
**PRIMARY EXAMINER**